

REMARKS/ARGUMENTS

Claims 1, 2, 5-13, 16, 17, 23-25 and 34 are pending. No claim amendments are being made at this time.

Inventorship Change

The Examiner notes that the reissue declaration refers to a concurrent petition under 37 CFR 1.324 and motion under 37 CFR 1.634 but states that she is unable to find such in the record of the case. Applicants are also unable to find such petition or motion. However, applicant note that MPEP 1412.04 provides:

The reissue application with its reissue oath or declaration under 37 CFR 1.175 provides a complete mechanism to correct inventorship. See *A.F. Stoddard & Co. v. Dann*, 564 F.2d at 567, 195 USPQ at 106. A request under 37 CFR 1.48 or a petition under 37 CFR 1.324 cannot be used to correct the inventorship of a reissue application. If a request under 37 CFR 1.48 or a petition under 37 CFR 1.324 is filed in a reissue application, the request or petition should be dismissed and the processing or petition fee refunded. The material submitted with the request or petition should then be considered to determine if it complies with 37 CFR 1.175. If the material submitted with the request or petition does comply with the requirements of 37 CFR 1.175 (and the reissue application is otherwise in order), the correction of inventorship will be permitted as a correction of an error in the patent under 35 U.S.C. 251.

(MPEP, 8th Edition, Rev. 5, August 2006, Section 1412.04, pp. 1400-29 to 30)

In light of the above, it is believed that a petition under 37 CFR 1.324 would not have been appropriate, and instead the reissue declaration was not only a permissible route but the only means to correct the inventorship. Thus, it is respectfully submitted that the change of inventorship should be effected as requested in the Reissue Declaration filed January 15, 1999.

Rejection

The Examiner maintains the rejection that the original declaration defective in not referring to a "heterologous" gene segment in claim 30, and says that a substitute declaration is required to address the "linked on a single vector" element of the current claims. The Examiner further states that the supplemental declaration attached to the amendment mailed January 26,

2008 has not been officially filed with the USPTO, and that a petition, fee and supporting documents also need to be filed.

In reply, Applicants submit the supplemental declaration and a petition under 37 CFR §1.47(a) along with the fee and supporting documents have been filed with the USPTO. A petition under 37 CFR §1.47(a) is filed because one of the two inventors, Donna E. Prunkard, has declined to sign the supplemental declaration.

The supplemental declaration attests that every error corrected in the set of claims filed with the application including the reference to a heterologous gene segment in claim 30 arose without experimental error. The declaration further attests that every error corrected in the currently pending claims arose without any deceptive intent.

Accordingly, it is respectfully requested that the rejection be withdrawn upon the granting of the petition by the Office of Petitions.

Improper Final Rejection

It is respectfully submitted that the finality of the Office Action mailed May 7, 2008 in the first office action following an RCE is premature because the office action raises new issues. Specifically, the Examiner has for the first time questioned the sufficiency of inventorship correction. Also, although the issue of the sufficiency of the reissue declaration had been previously raised, applicants had submitted new evidence in an attempt to address that concern (i.e., the 1.47(a) submission) and the present office action raises a new issue with respect to the sufficiency of that submission which is addressed in the current response. Withdrawal of the finality is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 650-326-2400.

Respectfully submitted,



Joe Liebeschuetz
Reg. No. 37,505

Appl. No. 09/232,488
Amdt. dated August 6, 2008
Amendment under 37 CFR 1.116 Expedited Procedure
Examining Group 1632

PATENT

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, Eighth Floor
San Francisco, California 94111-3834
Tel: 650-326-2400
Fax: 415-576-0300
Attachments
JOL:yew
61456191 v1